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EXAMINER

RASCH, P

ART UNIT

PAPER NUMBER

6

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23041/9906

2500

DATE MAILED:

09/06/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☒ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-41 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-41 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

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Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

2. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for positioning a check to be printed of claim 40 must be shown or the feature cancelled from the claim. No new matter should be entered.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

4. Claim 40 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

5. Claims 7, 12, 15 and 29 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly

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point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "predetermined" renders the claim indefinite because a comparative word such as "predetermined" can mean virtually anything and it is not known how much or how great an amount will constitute a "predetermined" product, a "predetermined" amount or a "predetermined" manner for associating or selecting information with a plurality of products. See *Norton Co. v. Bendix Corp.*, 171 USPQ 449 (2d Cir. 1971). Claims 13-21 are rejected due to their dependency on claim 12. Claim 30 is rejected due to its dependency on claim 29.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4, 7-9 and 22, 23, 27-32, 35 and 37 are rejected under 35 U.S.C. § 102(b) as being anticipated by Mindrum et al. As best seen in FIG. 1, Mindrum et al. discloses a method and apparatus for creating a discount coupon in response to the purchase of a product other than the one to which the coupon

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applies. Each store has a point-of-sale (POS) controller **10** and a plurality of checkout terminals **12**, each having an associated optical scanner **13**. A number of files **14** are used by the controller to provide information to the terminals **12**. The files **14** contain a record for each product in the store and are used to access price and other information concerning the product (col. 4, lines 17-27). The store controller **10** is coupled to a retailer host computer **16**, as indicated by line **18**, which may be a telephone line or some other communication link (col. 4, lines 28-30).

At least one POS terminal **12** has a coupon printer **24** capable of reproducing a bar-type code in UPC format and means for identifying a triggering product which has been selected by a manufacturer to trigger the printing of a coupon for one of the manufacturer's products (col. 4, lines 41-48). More specifically, the means for identifying a triggering product includes an item file with a triggering field contained within each product record, and means for checking the triggering field as each product purchase is processed (col. 2, lines 17-21).

The apparatus also includes means for validating a coupon by reading the bar code on the coupon and comparing the bar code information with data contained in a coupon deal record. The coupon is valid only if the date is within the validity period of the coupon deal and the manufacturer's code and product family

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group code on the coupon match similar codes in a product that was purchased (col. 2, lines 39-51). The coupon may be one that was created at the store or it may be a conventional coupon (col. 12, lines 25-28). A means for automatically applying a discount to the customer order is responsive to the means for validating the coupon (col. 2, lines 52-54). The system may also include means for triggering the creation of a coupon in response to the redemption of another coupon that was previously printed by the apparatus of the invention (col. 2, lines 62-65).

The corresponding method includes the steps of identifying a triggering product from among a sequence of products purchased by a customer, associating the triggering product with at least one coupon deal involving a discount on a product different from the triggering product, and automatically printing a machine-readable coupon for the customer (col. 3, lines 1-4). The steps of coupon validation and redemption include reading a previously created discount coupon, extracting a coupon look-up number from the coupon information, retrieving a coupon deal record corresponding to the coupon presented for validation, comparing a date read from the coupon with an expiration date in the coupon deal record, comparing the manufacturer's code and product family code in the coupon deal record with corresponding codes in each product purchased by the customer, and indicating whether the coupon is a valid one (col. 3, lines 21-31). If the coupon is

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valid, the redemption process also includes applying a discount to the customer's transaction total and may include initiating creation of preselected coupon in response to the redemption of another coupon (col. 3, lines 31-36).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

9. Claims 5, 6, 24-26 and 34 are rejected under 35 U.S.C. § 103 as being unpatentable over Mindrum et al.

With respect to claims 5, 24 and 34, Mindrum et al. discloses that claimed invention, as stated above for claims 1

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and 22, except for rendering the conventional discount coupon unredeemable. However, Mindrum et al. does mention that an invalid coupon is rejected in step **168** (col. 13, lines 33-36) which is identical to step **724** in the present invention. The coupon in the present invention is invalidated by inking over the coupon's bar code (p. 41, lines 9-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to ink over the coupon's bar code since it was known in the art that a coupon may be invalidated by defacing indicia on the coupon so that such invalidation is readily apparent to an observer.

With respect to claims 6 and 25, Mindrum et al. discloses that claimed invention as stated above for claims 1 and 22, respectively, except for checking whether magnetic ink is provided on coupon. However, the Examiner takes Official Notice that information on an item in the form of magnetic ink characters is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to check whether magnetic ink is provided on a coupon since it was known in the art that the presence of magnetic ink characters can be used to determine if machine readable information is provided on an item.

With respect to claims 10, 11, 33 and 36, Mindrum et al. discloses the claimed invention, as stated in claims 1 and 22

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above, except for obtaining cash or a printed check (conventional or promotional) in exchange for a coupon. It would have been obvious to one having ordinary skill in the art at the time the invention was made to obtain cash or a printed check since the examiner takes Official Notice of the equivalence of cash payment or a printed check in lieu of a reduction of the price of the item for their use in the coupon art and the selection of any of these known equivalents provides a monetary gain to the customer that would be within the level of ordinary skill in the art.

With respect to claim 26, Mindrum et al. discloses the claimed invention, as stated in claim 22 above, except for a slot means of a size for receiving substantially any one of different sizes of conventional coupons. However, the Examiner takes Official Notice that changing the size of an opening or slot allows for different sized items to be inserted into said opening or slot. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide different sized openings or slots since it was known in the art that different sized openings or slots can be used to allow different sized items to be inserted into said openings or slots.

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10. Claims 38, 39 and 41 are rejected under 35 U.S.C. § 103 as being unpatentable over Mindrum et al.

With respect to claims 38 and 39, Mindrum et al. discloses the claimed invention except for the printing means providing a check with the payor different than the seller and having an amount of a redeemed coupon. (See discussion in claim 1) It would have been obvious to one having ordinary skill in the art at the time the invention was made since the examiner takes Official Notice of the equivalence of a printed check with a payor different than the seller in lieu of a reduction of the price of the item for their use in the coupon art and the selection of any of these known equivalents to provide a monetary gain to the customer would be within the level of ordinary skill in the art.

With respect to claim 40 and as stated in claims 38 and 39 above, Mindrum et al. discloses the claimed invention except for rendering the coupon unacceptable for further redemption. As stated in claims 5, 24 and 34 above, Mindrum et al. does mention that an invalid coupon is rejected in step **168** (col. 13, lines 33-36) which is identical to step **724** in the present invention. The coupon in the present invention is invalidated by inking over the coupon's bar code (p. 41, lines 9-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to ink over the coupon's bar code

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since it was known in the art that a coupon may be invalidated by defacing indicia on the coupon so that such invalidation is readily apparent to an observer.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 5,008,519 to Cunningham et al. discloses a coupon redemption system in which a manufacturer's coupon having a UPC label is read by a special device at the supermarket and verified. The device communicates the results of the validation to the cash register for credit to the consumer's bill. The accepted coupon is mutilated to prevent reuse.

U.S. Patent 4,634,147 to McClure discloses a coupon redeemable at a cash value at retail stores. The coupon includes product identification indicia and location indicia in the form of a bar code.

U.S. Patent 5,208,445 to Nahar et al. discloses a method and apparatus for receiving, marking and retaining discount coupons in which the apparatus accepts coupons to be genuine and then marks the coupons to prevent reuse.

U.S. Patent 4,540,880 to Hipko discloses a UPC coupon which can be redeemed at a store.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Rashid whose telephone number is (703) 305-3489.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

BR

Peter J. Rashid
August 24, 1994

Davis L. Willis

DAVIS L. WILLIS
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 255